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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/718,379      | 11/20/2003  | Chelsea Shields      | 2838                | 9527             |

50855 7590 11/14/2006

UNITED STATES SURGICAL,  
A DIVISION OF TYCO HEALTHCARE GROUP LP  
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NORTH HAVEN, CT 06473

EXAMINER

ROANE, AARON F

ART UNIT PAPER NUMBER

3739

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/718,379             | SHIELDS ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Aaron Roane            | 3739                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3-9, 11-16, 18 and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                              |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| Paper No(s)/Mail Date <u>6/12/06, 3/20/06</u> .  | 6) <input checked="" type="checkbox"/> Other: <u>IDS: 6/3/05, 8/26/04, 3/17/04</u> . |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of specie #1, subspecie A and sub-2specie II in the reply filed on 4/27/2006 is acknowledged.

Applicant respectfully disagreed with the examiner's assessment that no claims were generic, by pointing out the claims 1, 2, 7, 17 and 19-22 are believed (by Applicant) to be generic, see page 1, last two lines through the first line of page 2. However, Applicant is mistaken since claims 1, 2, 7, 17 and 19-22 are not drawn to sub-2specie I and therefore are not generic.

Applicant elects claims 1, 2, 7, 10, 17 and 19-22, see page 1, lines 3-4 from the last line. However, claim 7 depends on claim 6, claim 6 depends on claim 3 and both claims 3 and 6 have been withdrawn by Applicant, therefore, claim 7 is withdrawn by the examiner as being drawn to a non elected specie, subspecie and sub-2specie.

Claims 1, 2, 10, 17 and 19-22 will be examined.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (USPN 4,127,222).

Regarding claims 1 and 19, Adams discloses a device (10) comprising a tissue contacting wall (26 and portion of 18 adjacent to 26 and analogous counterparts in other embodiments) including a plurality of apertures (21 and analogous counterparts in other embodiments) formed therethrough, wherein the tissue contacting wall is fabricated from a non-conductive (plastic, and/or rubber) material, see col. 2-4 and figures 1-5.

Regarding claim 10, Adams further discloses a pair of side walls (each oppositely facing each other and disposed between the tissue contacting wall and the bottom wall) extending from lateral side edges of the tissue contacting wall, and a bottom wall (28 and portion of 18 adjacent to 28 and analogous counterparts in other embodiments) interconnecting the pair of side walls, the tissue contacting wall, the bottom wall and the side walls defining a cavity, see col. 2-4 and figures 1-7.

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Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Tetzlaff et al. (USPN 6,277,117 B1).

Regarding claim 19, Tetzlaff et al. disclose an over shoe for use with electrosurgical instruments capable of performing tissue sealing, the over shoe comprising, a tissue contacting wall fabricated from a plastic non-conductive material (overmolding side of 121 immediately adjacent 125), the tissue contacting wall being configured and dimensioned to over lie an electrically conductive surface (electrically conductive 126) disposed on the electrosurgical instrument, the tissue contacting wall including at least one aperture extending therethrough (the “overmolding” of 121 provides an aperture defined by the lip/rim of the overmolding), see col. 3-7, particularly col. 6, lines 36-49 and figures 1-7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (USPN 6,726,068 B2).

Regarding claim 2, Miller discloses a device (10) comprising a tissue contacting wall (flattened portion of 14 and analogous counterparts in other embodiments) including a plurality of apertures (24 see col. 4, lines 1-12 and figure 5) formed therethrough, see col. 2-4 and figures 1-5. Additionally, Miller teaches that it is known in the art to provide thimbles made of ceramic, see col. 2, lines 16-19. Finally, Miller teaches that one or more holes (24) maybe placed on the back side or the side nearest the finger nail in order to prevent moisture buildup, see col. 4, lines 1-12. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the conventional ceramic thimble as disclosed by Miller, as taught by Miller, to provide one or more holes maybe placed on one side, the back side or the side nearest the finger nail in order to prevent moisture buildup.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (USPN 4,127,222).

Regarding claim 17, Adams discloses the claimed invention except for reciting that the tissue contacting wall has a thickness in the range of about 10  $\mu\text{m}$  to about 2mm. The examiner takes official notice of the recited thickness range as a) the upper bound is a factor of 200 times bigger than the lower bound and the range is so large as to be 1) well

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known and/or 2) non-critical and b) the recited range is well within what one of ordinary skill expect for a thimble wall thickness.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetzlaff et al.

(USPN 6,277,117 B1) in view of Penneck (WO 89/00757).

Regarding claims 20-22, Tetzlaff et al. disclose the claimed invention except for reciting that the tissue contacting surface is made of a material having a high comparative tracking index (CTI), the CTI is between 300 and 600 volts and that the material is fabricated from a group consisting of at least one of nylon, syndiotactic polystyrenes, polybutylene terephthalate, polycarbonate, acrylonitrile butadiene styrene, polyphthalamide, polymide, polyethylene terephthalate, polyimide, acrylic, polystyrene, polyether sulfone, aliphatic polyketone, acetal copolymer, polyurethane, nylon with polyphenylene-oxide dispersion and acrylonitrile styrene acrylate. Penneck discloses an electrical conductor and teaches providing an outer insulative layer made of acrylic having a comparative tracking index of at least 300 V in order to resist "dry arcing and wet tracking", see specifically abstract and generally the entire reference.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.R.

*A.R.*  
June 21, 2006

*Roy D. Gibson*  
**ROY D. GIBSON**  
**PRIMARY EXAMINER**